

Serial No. 10/707,567
Filed: 12/22/2003
Page 2 of 6

Examiner: Ricky D. Shafer
Group Art Unit: 2872

REMARKS

Initially, Applicant wishes to thank the Examiner for the courtesy of the telephonic interview afforded to Applicant's counsel on July 20, 2005, during which the scope and basis for the restriction requirement were more fully explained.

Claims 1-25 were in the application as filed. The Examiner has required restriction between allegedly patentably distinct Invention I (Claims 2-14) and Invention II (Claims 15-25). The Examiner has also required restriction between allegedly patentably distinct Species of Invention I, i.e. Species A (Figure 9), Species B (Figure 11), and Species C (Figure 13). The Examiner asserts that claim 1 is a linking claim for Invention I and Invention II, and that claims 1 and 2 are generic. The Examiner has also placed Invention I in Class 359, subclass 872, and Invention II in Class 359, subclass 877.

In restricting the Applicant's application to one of the above-identified groups, the Examiner has made too narrow a restriction requirement. Applicant respectfully requests that the Examiner consider the withdrawal of the restriction requirement in light of the arguments advanced herein. Alternatively, Applicant provisionally elects claims addressed to Invention II with traverse.

Restriction Requirement

The Examiner has required restriction between alleged Invention I (Claims 2-14), which comprises a mirror tilt actuator having an integrated ball-and-socket slip clutch assembly, and alleged Invention II (Claims 15-25), which comprises a mirror tilt actuator having a ball-and-socket assembly and a separate slip clutch assembly. The Examiner has also required restriction between alleged Species A (Figure 9), which comprises a helical socket compression spring, Species B (Figure 11), which comprises a circular split socket compression spring, and Species C (Figure 13), which comprises a triangular split socket compression spring. The restriction requirement is respectfully traversed as being improper.

Serial No. 10/707,567
Filed: 12/22/2003
Page 3 of 6

Examiner: Ricky D. Shafer
Group Art Unit: 2872

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. §121. Alleged Inventions I and II have the unifying concept of a mirror tilt actuator connected to a reflective element through a ball-and-socket joint that incorporates a slip clutch interposed between the actuator and the reflective element to enable relative movement between the two. Inventions I and II are not independent and distinct and, thus, should not be subject to restriction.

According to the Manual of Patent Examination Procedure §802.01, "independent" means that there is "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect." "Distinct" means that "two or more subjects as disclosed are related, for example, as a combination and a part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable over each other." (Emphasis added.)

Alleged Inventions I and II are dependent, not independent, because they both have the same basic ball-and-socket and slip clutch design, the same mode of operation, i.e. linear movement of a jackscrew attached to a reflective element through a ball-and-socket joint having a slip clutch to enable the actuator to continue to operate if the reflective element is immobilized, the same function, i.e. prevention of damage to the actuator when attempting to move an immobilized reflective element, and the same effect, i.e. prevention of damage to the actuator, and are therefore related. The only substantive difference between the Inventions is in the slip clutch, which is a ball engaging a socket in one embodiment and an annular rim engaging a plate in the other embodiment. The basic structure and operation of the actuators are the same in either case.

Moreover, alleged Inventions I and II have not been shown to be distinct because the Examiner has not shown that they are patentable over each other. Finally, a search of the prior art would not be duplicative and Applicant is at a loss as to how the Examiner would be

Serial No. 10/707,567
Filed: 12/22/2003
Page 4 of 6

Examiner: Ricky D. Shafer
Group Art Unit: 2872

burdened by having to examine all the groups of claims since they relate to such intertwined subject matter.

The Examiner supports his conclusion of distinctness by arguing that the Inventions have "acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification." However, the classification selections by the Examiner are arbitrary, and equally applicable to both the Inventions. Class 359, subclass 872, relates to a mirror including a structure for moving the mirror relative to a support structure. The Examiner assigns this classification to Invention I. Class 359, subclass 877, relates to a mirror, including a structure for moving the mirror relative to a support structure, and including a switch or motor which is activated to provide power to move the mirror. The Examiner assigns this classification to Invention II. However, class 359, subclass 872, could equally apply to Invention II and class 359, subclass 877, could equally apply to Invention I. The Examiner's argument that distinctness is shown by different classifications is unsupported by the classifications selected.

Similarly, Species A, B, and C are not separate and distinct. Species A, B, and C are virtually identical in design, function, and effect, since the three compression springs are identical in function (radially inward compression) and effect (compression of the socket), and differ but slightly in design. Furthermore, the Examiner has not shown that the three alleged Species are patentable over each other, and thus they have not been shown to be distinct.

As the Examiner is undoubtedly aware, 37 CFR 1.141(a) states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Serial No. 10/707,567
Filed: 12/22/2003
Page 5 of 6

Examiner: Ricky D. Shafer
Group Art Unit: 2872

See, also, Manual of Patent Examining Procedure, §§806.04(a), 806.04(h). Thus, 37 CFR 1.141(a) recognizes that a single application can properly include claims to a reasonable number of species greater than one provided the application includes an allowable generic claim from which the species claims depend. This is precisely the situation with respect to the Application at issue. While no decision has yet been made concerning the allowability of the generic claims, the species claims must be examined if a claim generic to the species is allowed. *See, MPEP §809.02(c).*

There is good reason to maintain all species claims in the application for examination pending allowance of one or more of the generic claims. The number of species, i.e. three, is not unreasonable. Applicant submits that there is a high likelihood that one or more of the generic claims will be allowed. Applicant would withdraw essentially only two claims pursuant to the species restriction requirement. Thus, the burden of maintaining the species claims in the application is negligible, and far outweighed by the burden of continuing examination of the withdrawn claims after allowance of one or more of the generic claims. Nevertheless, Applicant confirms a provisional election with traverse of alleged Invention I, claims 1-4, and 7-14.

Election of Species

Applicant provisionally elects alleged Invention I, claims 1-4, and 7-14, with traverse.

The Examiner has identified claim 1 as a linking claim for alleged Inventions I and II, and claims 1 and 2 as generic to the alleged Species. As the Examiner is undoubtedly aware, MPEP §809.02(c) states:

(B) When a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment shall be as follows:

(1) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be

Serial No. 10/707,567
Filed: 12/22/2003
Page 6 of 6

Examiner: Ricky D. Shafer
Group Art Unit: 2872

advised of the allowable generic claim and that **claims drawn to the nonelected species are no longer withdrawn** since they are fully embraced by the allowed generic claim. (Emphasis added.)

Upon the allowance of either or both of the linking claim and the generic claim, Applicant will be entitled to consideration of claims 5, 6, and 15-25 as drawn to the invention or species which is non-elected as a result of the restriction requirement. *See, 37 CFR 1.146.*

CONCLUSION

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

IAN BODDY

Dated: July 21, 2005

By: 

G. Thomas Williams, Reg. No. 42,228
Michael F. Kelly, Reg. No. 50,859
McGarry Bair PC
171 Monroe Avenue, N.W., Suite 600
Grand Rapids, Michigan 49503
(616) 742-3500

G0177695.DOC